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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,601	11/21/2001	John E. Krech	57135US002	3879

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/990,601

Applicant(s)

KRECH ET AL.

Examiner

Walter B Aughenbaugh

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--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See continuation sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 30-37.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10.
10. ☐ Other: _____

ADVISORY ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claim 30 in the After-Final Amendment filed October 21, 2003 (Paper 12) have been received, considered and entered by Examiner.
2. The cancellation of claims 1-29 and 38-45 in Paper 12 has been entered by Examiner.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. 112 rejection of claims 8, 24 and 39 made of record in paragraph 10 of Paper 9 has been withdrawn due to Applicant's cancellation of claims 8, 24 and 39 in Paper 12.
4. The 35 U.S.C. 103 rejections of claims 1-29 and 38-45 made of record in paragraphs 13-17, 21 and 22 of Paper 9 have been withdrawn due to Applicant's cancellation of claims 1-29 and 38-45 in Paper 12.

REPEATED REJECTIONS

5. The 35 U.S.C. 102(b) rejection of claims 30-32 and 37 as anticipated by Nagano et al. made of record in paragraph 12 of Paper 9 has been repeated for the reasons previously made of record in paragraph 12 of Paper 9. In regard to claim 37, note that Nagano et al. teach that the polyolefin contains 1 to 10 wt.% antimony trioxide (page 4, paragraph 0014 of Nagano et al.) and that Examples of Practice 1 and 2 of Nagano et al. teach that the composition includes "6 wt. parts of antimony trioxide" (paragraphs 0019 and 0025), a range (1 to 10 wt. %) and a value (6 wt. parts) that fall within the range claimed in claim 37 of the instant application.
6. The 35 U.S.C. 103(a) rejection of claims 33 and 34 over Nagano et al. in view of Perez et al. made of record in paragraph 18 of Paper 9 has been repeated for the reasons previously made of record in paragraph 18 of Paper 9.

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7. The 35 U.S.C. 103(a) rejection of claim 35 over Nagano et al. in view of Ueeda et al. made of record in paragraph 19 of Paper 9 has been repeated for the reasons previously made of record in paragraph 19 of Paper 9.

8. The 35 U.S.C. 103(a) rejection of claim 36 over Nagano et al. in view of Nakacho et al. made of record in paragraph 20 of Paper 9 has been repeated for the reasons previously made of record in paragraph 20 of Paper 9.

ANSWERS TO APPLICANT'S ARGUMENTS

9. Applicant's summary of the amendments to claim 30 in the second paragraph of page 4 of Paper 12 incorrectly states that "All halogenated flame retardants (including halogenated epoxy) are expressly excluded from the claim"; claim 30 as amended recites that the composition (that the plastic container comprises) "contains a flame retardant, said flame retardant being selected from the group consisting of non-halogenated flame retardants". While claim 30 as amended requires that "a flame retardant" in the composition is "selected from the group consisting of non-halogenated flame retardants", the language of claim 30 does not exclude halogenated flame retardants from the scope of the claim as Applicant alleges. The transitional phrase indicator "comprising" is an open transitional phrase indicator.

10. Applicant's arguments on page 5 of Paper 12 in regard to the 35 U.S.C. 102(b) rejection of claims 30-32 and 37 as anticipated by Nagano et al. have been fully considered but are not persuasive.

Nagano et al. plainly teach that the composition of the pallet "contains polyolefin, halogenized epoxy resin and other fire proofing agents" where "[an]other fire proofing agent is antimony trioxide". (paragraphs 0007 and 0008). This embodiment taught by Nagano et al.

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plainly reads on claim 30 of the instant application. As discussed above, the language of claim 30 does not exclude halogenated flame retardants from the scope of the claim. Applicant argues that “All working Examples of Nagano et al. disclose halogenized epoxy”, but the language of claim 30 does not exclude halogenated flame retardants from the scope of the claim. Note that both “working Examples of Nagano et al.” teach antimony trioxide, a non-halogenated flame retardant as claimed in 30 of the instant application. Applicant argues that Nagano et al. “teach away from providing a fire proof pallet of good impact strength without halogenized epoxy”; this argument is irrelevant because the language of claim 30 does not exclude halogenated flame retardants from the scope of the claim.

11. Applicant’s arguments on pages 6-7 of Paper 12 in regard to the 35 U.S.C. 103(a) rejection of claims 33 and 34 over Nagano et al. in view of Perez et al. have been fully considered but are not persuasive.

Applicant takes issue with Examiner’s statement on page 10 of Paper 9 that “any foam can be considered to be ‘structural’” (Applicant misquotes the statement as “any foam can be considered structural” on page 6 of Paper 12). The first definition of the word “structure” from the copy of the dictionary page that Applicant provided is “of, relating to, having, or characterized by structure”. The foam of Perez has a certain (foam or porous) structure and is characterized by a foam or porous structure, thus complying with the above-quoted definition. Furthermore, the foam of Perez is a component of the storage vessel of Perez et al. and therefore necessarily contributes to the structure of the storage vessel of Perez et al. As for the definition that Applicant cites, “used in or necessary to building”, the foam of Perez et al. is “used in... building” the storage vessel of Perez et al. and the foam of Perez et al. is “necessary to building”

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the storage vessel of Perez et al. because it is a component of the storage vessel; the meaning of “structural foam” is much broader than Applicant’s proposed, contrived meaning of “foam shaped for use in construction”. As can be understood from the above discussion; the word “structural” does not solely relate to “weight bearing parts” as Applicant alleges. In response to the entirety of Applicant’s arguments in regard to claim 34, the language of claim 30 does not exclude halogenated flame retardants from the scope of the claim as discussed above.

12. Applicant’s arguments on page 7 of Paper 12 in regard to the 35 U.S.C. 103(a) rejection of claim 35 over Nagano et al. in view of Ueeda et al. have been fully considered but are not persuasive.

Applicant argues that “no epoxy is mentioned or suggested”, but Nagano et al. teach a mixture of a polyolefin such as polypropylene and epoxy, and Ueeda et al. teach that another resin may be blended with polypropylene as previously made of record in the rejection of claim 35. In response to Applicant’s piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). In response to Applicant’s argument that Nagano et al. do not teach a “plastic container containing a non-halogenated flame retardant as its sole flame retardant”, the limitations on which the Applicant relies (i.e. a non-halogenated flame retardant as the sole flame retardant) are not stated in the claims. It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

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13. Applicant's arguments on page 8 of Paper 12 in regard to the 35 U.S.C. 103(a) rejection of claim 36 over Nagano et al. in view of Nakacho et al. have been fully considered but are not persuasive.

Applicant argues that "no combination of thermoplastic and [presumably, thermoset] resin are taught or suggested" by Nakacho et al., but Nakacho et al. teach that an epoxy resin or epoxy resins are exemplary additives (col. 14, lines 40-49 and line 60); in the case of the use of a thermoplastic resin as a component of the flame-retardant composition of Nakacho et al., use of an epoxy resin or resins as an additive would render the composition a combination of thermoplastic and thermoset resins. Therefore, Nakacho et al. teach a flame retardant "used in a combined thermoplastic/thermoset composition" despite Applicant's argument to the contrary. In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). Nagano et al. also teach a flame retardant "used in a combined thermoplastic/thermoset composition"; Nakacho et al. is used for its teaching that ammonium phosphate can be used in place of, or along with, the antimony trioxide of Nagano et al.

14. In response to Applicant's general argument that the claims of the instant application were improperly "reconstruct[ed]" by "picking and choosing pieces of four references", the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). The test for combining references is what the combination of disclosures taken as a whole would suggest to

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one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). The combinations of references proposed in the text of the rejection of the claims are appropriate as supported in the response to Applicant's arguments provided above.

15. In response to Applicant's general argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). The combinations of references proposed in the text of the rejection of the claims are appropriate as supported in the response to Applicant's arguments provided above.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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11/03/03

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
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11/8/03